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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER	
REICHLE, K	
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3761	9

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/216545	Roessler et al
Examiner	**Group Art Unit**
Reichle	3761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P ri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 12-14-98.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☒ The drawing(s) filed on 12-14-98 is/are objected to by the Examiner.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☒ Information Disclosure Stat ment(s), PTO-1449, Paper No(s). 2-5, 7-8

☐ Intervi w Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

The prior art cited in the specification has been noted but will not appear on the front of a patent, if any, unless cited on an accompanying PTO 892 or 1449, since such citations are not in compliance with 37 CFR 1.56 and 1.97 and 1.98.

Incorporation of essential material, i.e. claimed subject matter, by reference to a foreign application or patent or to a U.S. application or patent which itself incorporates essential material by incorporation by reference is improper. Applicants should review any incorporations in this application to ensure their propriety.

The drawings are objected to because in Figure 3, 74 does not denote a seam. Figure 4 and the description on page 21, line 4 - page 24, last line are inconsistent, see discussion infra. In Figure 4, where is 78? 76? Correction is required.

The formal drawings filed 12-20-99 have been placed in the application file. However, approval thereof is held in abeyance until such time as all the drawing objections have been overcome.

The use of the trademarks on pages 26-27 has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters, without the trademark symbol, unaccompanied by the terminology "brand" or "type" and accompanied by generic terminology.

The abstract of the disclosure is objected to because the terminology "pant-like" is unclear, i.e. how like a pant? Also, the abstract, i.e. a description as the disclosed invention, e.g. apparatus, and the disclosed invention, e.g. apparatus and method, are not consistent in scope. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: 1)The Summary of the Invention Section, i.e. a description of the claimed invention, and the invention as claimed are not consistent in scope. 2) the term "pant-like" used the throughout the description is unclear, i.e. how like pants? 3) On pages 21-24, Applicants disclose a number of methods but refer to Figure 4 which only shows one of the methods. The Figure and the description should consistently describe one method and indicate the other methods as not shown.

Appropriate correction is required

Claims 1-25 and 28 are objected to because of the following informalities: in claim 1, line 4, before "comprising", -- further -- should be inserted. This also applies to claims 9 and 15. In claims 4, 12, 17 and 28, the terminology "type" should be avoided. Appropriate correction is required.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 9, 15 and 26, the terminology "pant-like" is unclear, i.e. how like pants? Shape? Composition? Use? In claim 1, a positive structural antecedent basis for "said side edge... article "(lines 12-14 and 15-16) should be defined. This also applies to similar language in claims 9 and 15. Claim 21 is unclear, i.e. is each side panel connected to each side edge? In regard to claim 26, a positive structural antecedent basis for "said opposite waist region ' (line 11) should be set forth.

The transmittal papers indicate an assignment was supposedly filed on 12-18-98. However, no such assignment appears in the file wrapper. Applicant is requested to file a copy of such assignment.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-8, 15-20 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by McNichols, US '805.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See Figures, column 13, line 23 and column 16, lines 15-17.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 15, 17, 20, 23-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,036,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the effective filing date of the application is after that of the patent only a

"one-way" obviousness determination is made, i.e does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? The answer is yes because the claims obviously define or claim the absorbent article made by the method disclosed and claimed in the patent or the end product of the method includes all the claimed structure of the application claims.

Claims 1-7, 9-14 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Weil et al , U.S. '436.

See Figures, column 14, lines 31-56, column 15, lines 59-63, column 23, lines 17-24, column 24, lines 10-19, and there by U.S. Patent No. 4,938,753, column 32, lines 6-12. With regard to claims 26-28, such claims are product by process claims. In accord with MPEP 2113, even though the Weil product was made by different process, since the end product of Weil is the same as the end product of claims 26-28, the claims do not distinguished over Weil.

Claims ~~1 and 8~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Sosalla et al, US '401.

See Figures, column 22, lines 34-43, column 23, lines 2-14, column 24, lines 30-58.

Claims 15-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsson, GB '316.

See Figures, abstract, page 2, first full paragraph, page 5, line 29- page 7, line 10.

Claims 15, 21-22, 24, 26-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al, US '634.

See Figures, column 3, lines 35-40 and column 7, line 68 - column 8, line 15, side panels 15, releasable bond D, adhesive on 6 is fastener, front panel can be 6, back panel be A1, A3 or both. See also discussion of product by process which also applies here.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view of Bruemmer, US '873.

The Larsson reference teaches all the claimed structure except for a releasable bond defining a peel strength more than 1500 grams or in other words the maximum force allowing opening or unfastening of the bond. However, Bruemmer at column 4, lines 55 - column 5, line 4 teaches fasteners having a maximum unfastening force of no more than about 1500 grams so as

to permit on adult to open such fastener but prevent a child from doing so. Therefore, to employ a releasable bond defining a peel strength of no more than 1500 grams on the Larsson device would lack an inventive step as such would be obvious to allow opening by the adult but prevent a child from doing so as taught by Bruemmer and the desirability of appropriate opening by Larsson.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other prior art shows various pant absorbent products.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

K. M. Reichle

Karin M. Reichle
Patent Examiner

K. Reichle:bhw

November 7, 2000